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In re application of Anita Diu-Hercend et al. : DECISION ON PETITION
Serial No. : 09/674,109 :
Filed : June 21, 2001 :
Attorney Docket No.: 1461353 :
:

This is in response to applicants' petition, filed February 25, 2004 under 37 CFR 1.144, to withdraw the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Stage of PCT/EP99/02722, filed April 22 1999, which claims priority to European patent applications 98401007.4 and 98402254.1, filed April 24 1998 and September 11, 1998, respectively. The application, as filed with preliminary amendments, contained claims 13-28. In a first Office action mailed April 28, 2003, the examiner set forth a restriction / lack of unity requirement under 35 U.S.C. 121 and 372 dividing the claims into 360 groups. The claims recite 4 different assay methods utilizing any one of 90 different genes or gene products. Applicants were essentially required to elect one assay method utilizing one gene or gene product. On May 27, 2003 applicants filed a response in which the restriction requirement was traversed on essentially the same grounds argued in the petition. On November 19, 2003 the examiner mailed an Office action (non-final rejection) in which the restriction requirement was made final.

DISCUSSION

Applicants argue that all of the claims have unity of invention, the special technical feature being a method of screening for antimycotic compounds using "functionally similar" genes or gene products as targets. Review of the claims reveals that the only identified functional similarity is that the genes are "essential." This concept is not new. See for example, claim 62 of the Ribogene publication (WO 95/11969). Since this type of screening method is known in the art, the alleged novelty lies in the genes and gene products listed in the claims. Applicants have not disclosed any common structure, or indeed any common biological function, shared by the 90 genes and the corresponding proteins encoded thereby. Therefore the claims lack unity of invention within the meaning of PCT Rule 13.2.

DECISION

Applicants' petition is **DENIED**.

Since no fee is required for this petition, \$130.00 will be refunded to deposit account 02-2275, as directed.

The application will be forwarded to the examiner for consideration of the response filed February 25, 2004.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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